

**This Opinion is Not a
Precedent of the TTAB**

Mailed:
April 15, 2013

United States Patent and Trademark Office
Trademark Trial and Appeal Board

Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards

v.

Viña Casa Tamaya S.A.

Opposition No. 91189443
to application Serial No. 77561695

J. Scott Gerien and Aleson R. Clarke of Dickenson, Peatman & Fogarty for
Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards.

Stephanie H. Bald and David M. Kelly of Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP for Viña Casa Tamaya S.A..

Before Kuhlke, Lykos and Masiello, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Viña Casa Tamaya S.A. (“applicant”) filed an application to register the mark TAMAYA in standard character format for “wines” in International Class 33.¹ The application includes the following statement: “The English translation of the word ‘TAMAYA’ in the mark is ‘high lookout.’”

¹ Application Serial No. 77561695, filed September 3, 2008, pursuant to Section 1(a) of the Trademark Act, alleging January 2003 as the date of first use anywhere and in commerce.

Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards (“opposer”) opposed the registration of applicant’s mark on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with opposer’s previously used and registered mark MAYA also in standard character format for “wine” in International Class 33.²

In its answer to the notice of opposition, applicant admitted opposer’s ownership of its pleaded registration but otherwise denied the salient allegations therein.³

During applicant’s testimony period, proceedings were suspended pending resolution of a civil suit filed by applicant in federal district court. Applicant, who was in the position of plaintiff, sought a declaratory judgment that its TAMAYA mark does not infringe opposer’s MAYA mark. On April 26, 2011, the court granted opposer’s motion to dismiss the case for lack of subject matter jurisdiction, finding that the Board was the proper forum for resolving the parties’ dispute. *See Viña Casa Tamaya S.A. v. Oakville Hills Cellar Inc.*, 99 USPQ2d 1465, 1467 (S.D.N.Y. 2011). As the court explained:

² Registration No. 2508401, registered on November 20, 2001 on the Principal Register. The registration alleges August 1990 as the date of first use anywhere and September 1991 as the date of first use in commerce; Sections 8 and 15 affidavits acknowledged and accepted; renewed.

³ Applicant in its answer also asserted the affirmative defense of failure to state a claim upon which relief may be granted. Insofar as applicant neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived.

[P]laintiff has failed to show an “actual controversy” sufficient to establish federal jurisdiction pursuant to the Declaratory Judgment Act. The dispute between Viña Casa and Dalla Valle centers on Viña Casa's attempted registration—not use—of the TAMAYA mark. Viña Casa has been using the TAMAYA mark for more than seven years without objection from Dalla Valle. Only when Dalla Valle learned of Viña Casa's application to register the mark did Dalla Valle express opposition. And even then, Dalla Valle's February 6, 2009 cease-and-desist letter demanded simply that Viña Casa abandon its pending trademark application. Dalla Valle did not claim trademark infringement, contest plaintiff's continued use of the mark, or make any further demands. As a result of Viña Casa's failure to respond to the cease-and-desist letter, Dalla Valle formally filed a notice of opposition to plaintiff's registration application with the TTAB. Thus, what exists here is a dispute before the TTAB regarding registration of the TAMAYA mark.

Proceedings herein were subsequently resumed and the case is now fully briefed.

I. *The Record*

Pursuant to Trademark Rule 2.122(b), the record includes applicant's application file and the pleadings. In addition, the parties introduced the following:

A. *Opposer's Evidence*

Opposer properly made of record the following notices of reliance:

1. Opposer's Notice of Reliance No. 1, dated February 26, 2010, comprised of opposer's pleaded registration for the mark MAYA obtained from TARR (Ex. 1); an excerpt for the entries “Diaguita” and “South American Indian” from the *Encyclopedia Britannica* 2010 (Exs. 2 and 3); and a copy of an article entitled “Napa's Top 50 Cabernets” from the magazine *Wine Spectator*, November 15, 2006 (Ex. 4);
2. Opposer's Notice of Reliance No. 2, dated March 14, 2012, comprised of the file histories of other opposition proceed-

ings opposer has initiated before the Board (Exs. 1-6); excerpts for the entry “Mayacamas” from various publications and printouts from third-party websites discussing the term “Mayacamas” (Exs. 7-16); printouts from the www.kristillynnwine.com website and copies of the Certificates of Label Approval to illustrate the cessation of use of the MAIA LYNN trademark to identify a wine brand (Exs. 18-19); printouts from a third-party website to show that the MAYA restaurant in New York does not sell wine under that brand name (Ex. 20); printouts from third-party websites to show wine sold under the same mark originating from different countries (Exs. 21-23); a printout from wineanorak.com (Ex. 24); and printouts from third-party websites showing that the translation of “Mailina” is “piggy” or “piglet” (Exs. 25-26).

Opposer also introduced the testimony deposition of Naoko Dalla Valle, President of opposer (“Dalla Valle Deposition”).

B. *Applicant’s Evidence*

Applicant properly made of record the following notices of reliance all dated January 30, 2012:

1. Applicant’s Notice of Reliance No. 1, Exs. 1-52 comprised of TESS/TARR printouts of third-party applications and registrations for marks covering wine;
2. Applicant’s Notice of Reliance No. 2, Exs. 1-21 comprised of TESS/TARR printouts of third-party applications and registrations for marks MAYA, MAIA and MIA- formative marks for identical or related goods;
3. Applicant’s Notice of Reliance No. 3 comprised of a portion of the application file history of opposer’s pleaded MAYA mark which eventually matured into registration;
4. Applicant’s Notice of Reliance No. 4, Exs. 1-12 consisting of print and Internet dictionary definitions of the word “Maya;”

5. Applicant's Notice of Reliance No. 5, Exs. 1-2 consisting of printouts from the U.S. Social Security Administration's online Internet database for the name "Maya" and showing no results for the search "Tamaya;"
6. Applicant's Notice of Reliance No. 6, Exs. 1-10 comprised of TESS/TARR printouts of third-party applications and registrations for marks covering wine and alcoholic beverages;
7. Applicant's Notice of Reliance No. 7 consisting of printouts from Internet websites showing use of third-party marks comprised of MAYA, MAIA, or MIA and printouts from the U.S Department of the Treasury, Alcohol and Tobacco Tax and Trade Bureau;
8. Applicant's Notice of Reliance No. 8, Exs. 1-2 comprised of Internet printouts showing pricing of opposer's MAYA and applicant's TAMAYA wine products;
9. Applicant's Notice of Reliance No. 9, Exs. 1-7 comprised of Internet printouts from websites offering for sale wines sold under MAYA, MAIA and MIA- formative marks;
10. Applicant's Notice of Reliance No. 10 consisting of Opposer's Responses to Applicant's First Set of Requests for Production of Documents and Things Nos. 6 and 11;
11. Applicant's Notice of Reliance No. 11 consisting of Opposer's Responses to Applicant's First Set of Interrogatories Nos. 12-21, 23, 24, 33 and 34.
12. Applicant's Notice of Reliance No. 12 consisting of copies of court filings in the parties' federal suit in *Viña Casa Tamaya S.A. v. Oakville Hills Cellar Inc.*, 99 USPQ2d 1465 (S.D.N.Y. 2011);
13. Applicant's Notice of Reliance No. 13 consisting of Internet website printouts of third-party marks containing the identical or similar names for wine;
14. Applicant's Notice of Reliance No. 14 consisting of printouts from opposer's and applicant's websites;

15. Applicant's Notice of Reliance No. 15 consisting of excerpts from the Code of Federal Regulations; and

16. Applicant's Notice of Reliance No. 16 consisting of excerpted articles retrieved from the Lexis/Nexis database.

Applicant also introduced the following evidence:

1. Stipulation as to certain facts, dated February 13, 2012, Exs. 1-10 ("Stipulation of Facts"); and
2. Testimony deposition of Diego Callejas Hurtado, Commercial Director of applicant and Exs. 1-23 attached thereto ("Callejas Deposition").

II. *The Parties*

Opposer is a U.S. wine producer located in Napa Valley, California and organized under the laws of that state. Opposer selected the mark MAYA because it is the given name of the daughter of opposer's principal shareholder. Applicant's Notice of Reliance No. 3, Ex. 1. Opposer's MAYA wine is a blend of Cabernet Sauvignon and Cabernet Franc. Stipulation of Facts, ¶ 1. The labels for opposer's wines identify opposer as the producer and bottler of the wine and bear the appellation "Napa Valley." Stipulation of Facts, Ex. 6. Opposer's MAYA wines are sold at the high end of the U.S. market, priced at \$200-\$559 per bottle with some of opposer's pre-2005 vintages selling for thousands of dollars per bottle. Applicant's Notice of Reliance No. 8, Ex. 1; Stipulation of Facts, ¶ 7.

Applicant is a foreign wine producer located in the Limari Valley of Northern Chile. Callejas Deposition 18:6-18. Applicant selected the mark TAMAYA because it is the name of a hill on the property where applicant

produces its wines. Callejas Deposition 19:4-16, 19-21, 42:18-43:13. The word TAMAYA means “high lookout” or “highest looking-out point” in the Diaguita dialect, the language of the indigenous population who once inhabited the land where applicant’s wine is produced. *Id.* at 19:4-16; Applicant’s Notice of Reliance, Ex. 2. Applicant has sold a number of varieties of wine under the TAMAYA trademark in the United States including Carménère, Cabernet Sauvignon, Chardonnay, Syrah and Sauvignon Blanc. Callejas Deposition 18:25-19:3; 19:22-24; 21:22-24. To comply with U.S. regulations, applicant’s TAMAYA wine is labeled with “Chile” as the country of origin and “Limari Valley” as the appellation. Callejas Dep. 41:15-45:13, Ex. 8. Applicant markets and sells its wine to U.S. importers, distributors and various retail establishments such as restaurants, hotels, wine shops and grocery store chains (for example, Whole Foods, Harris Teeter, Win Dixie, and Kroger). Callejas Deposition 22:12-24:8; 27:5-11; Ex. 5. Approximately 1500 retail establishments currently offer applicant’s TAMAYA wines. *Id.* 29:22-30:2, Ex. 5. Applicant promotes its wine in a variety of ways, including print advertisements in trade publications, participation in trade shows, shelf-talkers in wine stores and its own website at tamayawines.cl. Callejas Deposition 15:15-17:20; 74:8-77:20, Exs. 10-13, 16-17, 86:8-22; Applicant’s Notice of Reliance 14, Ex. 2; Applicant’s Notice of Reliance No. 8, Ex. 2. The price point for applicant’s wine is relatively low at \$9.99-\$15.99 per bottle. Applicant’s Notice of Reliance No. 8, Ex. 2. Applicant’s wines sold under the TAMAYA trademark have received

unsolicited recognition from various publications in the wine industry such as *Wine Spectator* and *Wine Enthusiast* as “Best Buy,” “Value Buy” and “Value Brand of the Year.” Callejas Deposition 15:15-17:20, 46:23-56:12, Ex. 9.

III. *Standing*

Opposer has demonstrated through the TARR printout made of record with its first notice of reliance that it is the owner of its pleaded registration and that the registration is valid and subsisting. Because opposer’s registration is of record, opposer has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

IV. *Section 2(d) Claim*

We will now consider opposer’s Section 2(d) claim.

A. *Priority*

Priority is not in issue in view of opposer’s ownership of a valid and subsisting registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

B. *Likelihood of Confusion*

The remaining issue in this proceeding is likelihood of confusion. Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors are discussed below.

1. *The Marks*

First, we turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result.” *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

At the outset, we acknowledge some similarity regarding appearance insofar as opposer’s mark is comprised of the term “MAYA” and applicant shares that term in its mark. We also recognize that both marks include that

same sound. However, this is where the similarities end. Applicant's mark consists of three syllables and begins with the letters "T" and "A" which form the sound "ta-." Opposer's mark, by contrast, is two syllables and commences with the letter "M." As a result, the marks look different and are pronounced differently. This distinction is important since "it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered." *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark).

Moreover, the evidence of record shows that the connotation and overall commercial impression of the marks is quite distinct. According to the record, opposer's mark has different meanings well known to the U.S. public – that of a member of the Mayan people, the indigenous race of Indians in Southern Mexico and Central America and also the name of a girl. Applicant's Notice of Reliance No. 4, Ex. 1-12 (dictionary definitions of "Maya"); Applicant's Notice of Reliance No. 5. It is this second connotation that is actively promoted by opposer in advertising and marketing its wine. Opposer acknowledges that the name MAYA was chosen because it is the name of the daughter of opposer's principal shareholder. Applicant's Notice of Reliance No. 3, Ex. 1. U.S. Social Security records show that the name MAYA has been in the top 100 for girl's names for the past decade. Applicant's Notice of Reliance No. 5. Thus

consumers, upon encountering opposer's mark are likely to perceive the mark as meaning a popular female name.

By contrast, prospective consumers upon encountering applicant's mark TAMAYA are likely to perceive the mark as a coined term or as signifying the name of the hill in Chile where applicant's vineyard is located. As applicant testified:

Q: Why did the company select the name Tamaya?

A: Tamaya is the Diaguitas name.The Diaguitas [are] the Indians that used to inhabit where we have the winery. In their language "Tamaya" means "highest looking-out point." And actually, it's the name of the hill. And that hill is inside of our property.

Q: So it's the name of the actual hill on the property?

A: Yes.

Callejas Deposition 19:4-16.

The meaning and derivation of applicant's TAMAYA mark is explained and promoted to the public on its website as well as in marketing brochures. Callejas Deposition 78:2-80:11, Exs. 18-19; Applicant's Notice of Reliance No. 14, Ex. 2. By way of illustration, we note the following excerpt from applicant's website, www.tamaya.cl:

"Tamaya" in the Diaguita dialect means "high lookout," it is the name of the highest peak in the area and from there one can view the entire valley below.

In the vineyards of the Vina Tamaya we have found vestiges of the ancient Diaguita culture which reigned in this zone between

the 8th and 15th Centuries. Inspired by this culture, we named our winery Tamaya.

Applicant's Notice of Reliance No. 14, Ex. 2.

Based on the practices of the wine industry, opposer contends that because applicant's TAMAYA mark encompasses opposer's MAYA mark in its entirety, consumers are likely to be misled into believing that applicant's wine is another extension of opposer's product line. We disagree based on the different connotations and commercial impressions engendered by the marks as discussed above.

Opposer also argues that because the Diaguita dialect, the language of the South American Indians indigenous to the southern Andes, is obsolete and obscure, it is highly improbable that the ordinary U.S. consumer will "stop and translate" applicant's TAMAYA mark as "high lookout." As such, opposer maintains that the doctrine of foreign equivalents does not apply for purposes of comparing the involved marks. *See Palm Bay*, 73 USPQ2d at 1696. *See also In re La Peregrina Limited*, 86 USPQ2d 1645 (TTAB 2008). We agree with opposer that the ordinary U.S. consumer is unfamiliar with this obsolete foreign language and for this reason, the doctrine of foreign equivalents does not apply. That being said, prospective consumers are otherwise likely to perceive applicant's mark as a coined term. This is in contrast to opposer's mark MAYA, which as discussed above, has two well-known meanings to U.S. consumers.

In sum, in addition to the differences in sound and appearance, opposer's MAYA mark is significantly different in connotation and overall commercial impression from applicant's TAMAYA mark. Opposer's MAYA mark is likely to be perceived as either referring to the name of the indigenous Mayan people or a popular female name. Applicant's mark by contrast will either be perceived as a coined term or as a geographic place (the name of a hill) of the vineyard from which applicant's wine originates in Chile. As such, we find that the first *du Pont* factor weighs heavily against finding a likelihood of confusion.

2. *Strength of the Marks/Scope of Protection/Third-Party Uses*

We will now consider the strength of opposer's MAYA mark as well as the number and nature of similar marks in use on similar goods. "The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions." *Palm Bay*, 73 USPQ2d at 1694.

Opposer contends that because the term MAYA is arbitrary when used in relation to wine and because of its continuous use since 1992, it is entitled to a wide scope of protection. Opposer further points to prior oppositions it has initiated before the Board as well as other enforcement actions. Opposer's Brief, p. 18; Opposer's Notice of Reliance No. 2; Dalla Valle Deposition (*passim*).

Applicant however maintains that opposer's mark is diluted and weak in the wine industry. In support thereof, applicant has made of record third-party registrations to show that opposer's mark is diluted and entitled to a narrow scope of protection for wine and alcoholic beverages. Applicant's Notices of Reliance Nos. 1 and 6. Of those, we find the most relevant are Registration No. 1050905 for the mark MAYACAMAS for "wines;" Registration No. 2876022 for the mark DIVA MAYA for "alcoholic beverage, namely tequila;" and Registration No. 1613175 for the mark CAMAYA for "liqueurs." In addition, applicant has introduced excerpts from various web sites offering wine sold under the MAYACAMAS registered mark (Applicant's Notice of Reliance No. 9); extensive evidence of media recognition of the MAYACAMAS brand name; and evidence of other brands of wine incorporating the terms MAYA or MAIA such as LA MAIA LINA, ZUMAYA, and MAIANA from regional and national publications such as *The Washington Post*, *San Francisco Chronicle*, and *Atlanta Journal-Constitution*. Applicant's Notice of Reliance No. 16 (excerpted articles retrieved from the Lexis/Nexis database). Applicant has also made of record excerpts from the web sites flickeringwines.com, winehouse.com, winebid.com, winecommune.com and winex.com, each showing the offer for sale of both MAYA wines sold by opposer and MAYACAMAS wines sold by Mayacamas Vineyards, MAYACAMAS MOUNTAINS wines sold by Two Angels, and MAYCAMAS RANGE wines sold by Storybook Mountain. Applicant's Notice of Reliance No. 9, Ex. 2-7.

As we have often stated, because third-party registrations of marks are not evidence that the registered marks are in use, they are of limited probative value for demonstrating weakness of the marks. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). *See also* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:89 (4th ed. 2009) (“The mere citation of third-party registrations is not proof of third party uses for the purpose of showing a crowded field and relative weakness.”). In this instance, however, applicant has also submitted evidence of actual use of MAYACAMAS formative marks by three other entities as well as media references to marks for wine sold under marks such as MAYACAMAS, LA MAIA LINA, ZUMAYA, OLMAIA, and MAIANA. A close review of applicant’s evidence shows that the majority of media references to third-party use pertain to the MAYACAMAS mark. The record evidence shows that “Mayacamas” is the name of a mountain range in California. Opposer’s Notice of Reliance No. 2, Exs. 7-16. Based on this record, this relatively limited evidence of third-party usage balanced against the arbitrariness of opposer’s mark for wine and opposer’s policing efforts does not indicate significant weakness in opposer’s MAYA mark. We therefore find this factor to be neutral or slightly favoring a likelihood of confusion because opposer’s mark is conceptually strong.

3. *Fame*

We now consider the fifth *du Pont* factor of fame of opposer's pleaded mark. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer argues that its MAYA mark "is clearly famous within the wine industry segment" based on an article entitled "Napa's 50 Best Cabernets" published in *Wine Spectator* on November 15, 2006 ranking opposer's MAYA cabernet the seventh best in that category. Opposer's Brief, p. 18; Opposer's Notice of Reliance No. 1, Ex. 4. To bolster this assertion, opposer relies on the testimony of applicant's commercial director, Mr. Callejas Hurtado, that *Wine Spectator* is an "important" publication in the trade with nationwide distribution and a readership of over 1 million. Callejas Deposition 15:18-16:17. Opposer also points to the high cost of its MAYA wine as further evidence of fame by way of analogy that automobile consumers are familiar with the Rolls Royce brand of car. Opposer's Brief, p. 18.

A single, unsolicited instance of media exposure which occurred several years ago falls short of establishing opposer's MAYA mark as famous for likelihood of confusion purposes. Opposer submitted no evidence of U.S. sales figures, revenues, advertising expenditures or promotional efforts over a substantial period of time to support its showing of fame. *Compare Palm Bay, supra*, (VEUVE CLICQUOT found famous amongst purchasers of champagne and sparkling wine based upon sale in 8000 restaurants nationwide, liquor stores, wine shops and other retail establishments; extensive promotional campaign consisting of print advertisements in general interest magazines and in wine specialty magazines, radio ads, point-of-sale displays, wine tastings; unsolicited recognition in *New York Times*, *Boston Globe*, *Money Magazine*). Indeed, opposer acknowledges that it has never advertised its MAYA wine in print publications or at trade shows. Applicant's Notice of Reliance No. 11, Interrogatory Responses Nos. 33 and 34. Other than the *Wine Spectator* article, opposer introduced no evidence to support its assertion that its wine sold under the MAYA trademark enjoys wide brand name recognition amongst consumers. One instance of recognition in the wine industry from several years ago is insufficient to establish the level of fame as required under the fifth *du Pont* factor. This factor is therefore neutral.

4. *The Goods*

As identified, opposer's and applicant's goods are identical. In an attempt to distinguish the goods, applicant has submitted evidence explaining

the regulatory framework surrounding the labeling and advertising of wine in the United States as enforced by the U.S. Tobacco and Alcohol Bureau (“TTB”). In particular, applicant submitted excerpts from the U.S. Code of Federal Regulations which require that certain information must be set forth on the labels of bottled wine, including the brand name, country of origin, and the class, type or other designation (which may be satisfied by including an appellation of origin). Applicant’s Notice of Reliance No. 15, Ex. 1. Applicant argues that these labeling requirements mitigate against any likelihood of confusion because prospective purchasers will see that applicant’s wine originates from the Limari Valley of Chile whereas opposer’s wine is from Napa Valley California.

In an *inter partes* proceeding before the Board, the issue of likelihood of confusion must be determined based on the goods recited in applicant’s application vis-à-vis the goods identified in opposer’s pleaded registration. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846; *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Because both opposer and applicant have identified their goods as wine with no geographic limitations regarding their country of origin or other limitations as to type or appellation, for purposes of our likelihood of confusion analysis, the goods are legally identical and include all varietals of wines and appellations from all countries. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). This is not a federal trademark in-

fringement action but rather an administrative proceeding to determine whether applicant is entitled to a federal registration for the goods as identified in its application. Thus, the fact that applicant's wine originates from the Limari Valley in Chile and is labeled as such and opposer's wine is domestically produced from the Napa Valley in California has no bearing here. The identical nature of the goods weighs in favor of finding a likelihood of confusion.

5. *Trade Channels*

Turning now to the channels of trade, Mr. Callejas testified that to the best of his knowledge, applicant and opposer do not sell their respective wine products in the same trade channels. Callejas Deposition 30:19-23. Nonetheless, because both of the identifications of goods in the involved application and registration are identical and unrestricted as to trade channels, we must presume that both parties' identical products travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Again we emphasize that this is the standard for likelihood of confusion in a Board proceeding as opposed to the standard in a federal court infringement action. The ordinary trade and distribution channels for wine are wholesalers, restaurants, hotels as well as retail establishments such as liquor stores, wine merchants and for those states where permissible by law, grocery stores and

other retail outlets such as convenience stores. Hence, this *du Pont* factor, the relevant trade channels, weighs in favor of finding a likelihood of confusion.

6. *Purchasers and Conditions of Sale*

Next we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imports*, 73 USPQ2d at 1695.

The record here shows that while applicant's wine is relatively inexpensive with a retail price of \$9.99-\$15.99 per bottle, opposer's wine falls on the high end of the price scale with retail prices ranging from \$200-\$559 per bottle, and pre-2005 vintages selling for thousands of dollars per bottle. Applicant's Notice of Reliance No. 8, Ex. 1; Stipulation of Facts, ¶ 7. Opposer has also stated that purchasers of its MAYA wine blend "are likely to be relatively knowledgeable about wines." Stipulation of Facts, Ex. 2.

However, because the involved application and registration are unrestricted, we must assume that both applicant's and opposer's brands of wines are sold to the same purchasers under the same conditions. See e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (where both applicant's and registrant's goods were identified as "wine," applicant not permitted to distinguish its French wine by extrinsic evidence of higher quality

and price). While we acknowledge that consumers would exercise care in the purchase of a bottle of wine costing hundreds or thousands of dollars, because opposer's identification is not limited to wine sold at this price point, we must consider all types of wine, including those sold at a lower price point. Further, although wine in general may not be an "impulse purchase," there is not sufficient evidence in the record to support a finding that potential purchasers exercise a degree of care such that the conditions of sale would weigh in favor of applicant.

We find that the factors of relevant customers and conditions of sale weigh in favor of finding a likelihood of confusion.

7. *Actual Confusion/Contemporaneous Use*

According to the record, despite nearly a decade of contemporaneous use, neither party is aware of any instances of actual confusion by consumers of opposer's MAYA wines and applicant's TAMAYA wines. Applicant's Notice of Reliance No. 10, Ex. 1, Document Request Response No. 6; Callejas Deposition 93:5-15. The record shows that U.S. sales of applicant's TAMAYA mark have been substantial, totaling half a million bottles since 2002 and that applicant's wine is currently offered at approximately 1500 retail establishments. Callejas Deposition 33:4-38:3; Exs. 6 and 67; *Id.* at 29:22-30:2, Ex. 5. The record further shows that applicant has extensively promoted and advertised its mark, including in print publications with a national circulation aimed at wine aficionados (*Wine Enthusiast* and *Wine & Spirits*), national

trade shows and on its Internet web site. Callejas Deposition 55:13-91:15, Exs. 10-22. We do not however have any evidence regarding the extent of opposer's sales or promotional efforts. The evidence in the record regarding opposer's sales and promotional efforts indicates that opposer and applicant have not sold or advertised their products in the same venues. Thus, on this particular record, we are unable to assess whether there has been a sufficient opportunity for confusion to have actually occurred. Under these particular circumstances, the absence of any actual confusion is not entitled to probative weight. *Compare Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1174-5 (TTAB 2011). *See also, Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred). *But see Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring."). Accordingly, the seventh and eighth *du Pont* factors of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is neutral.

8. *Balancing the du Pont Factors*

In a particular case, any of the *du Pont* factors may play a dominant role. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In fact, in some

cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). In the present case, the record evidence shows that the dissimilarity of the marks and differences in commercial impression are so great as to outweigh the other *du Pont* factors, discussed above. Accordingly, we find that opposer has failed to prove its case by a preponderance of the evidence.

Decision: The opposition is dismissed.